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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/756,257	11/25/1996	JOHN D. SCHELLENBERG	4204.7-1	2922

27885 7590 01/08/2007  
FAY SHARPE LLP  
1100 SUPERIOR AVENUE, SEVENTH FLOOR  
CLEVELAND, OH 44114

EXAMINER
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SMITH, RUTH S

ART UNIT	PAPER NUMBER
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3737

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/08/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

08/756,257

Applicant(s)

SCHELLENBERG, JOHN D.

Examiner

Ruth S. Smith

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,7,9,11-13,15,22,26,29,31,42-45 and 47-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22,26,31,44 and 45 is/are allowed.
- 6) ☒ Claim(s) 15,29,47 and 48 is/are rejected.
- 7) ☒ Claim(s) 1,7,9,11-13,42-43,49 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 18, 2006 has been entered.

***Claim Objections***

Claims 1,7,9,11-13,42-43,49 are objected to because of the following informalities: In claim 1, it is unclear as to what the proposed target or the proposed trajectory is superimposed on. Claim 9 is inconsistent with the limitation of claim 1 which sets forth that the indicator is mounted on the tool. In claim 42, line 5, "its attached display" lacks antecedent basis. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15,47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manwaring et al in view of Wilk et al (WO 93/15648). Manwaring et al discloses an apparatus which includes a surgical tool and means for determining the actual position of the distal end of the tool relative to a desired position of the tool. Manwaring et al further provides a display for indicating such differences in position. Reference numeral 46 represents an indicator having electronic indicators which provide an indication to a human operator of a direction in which the tool should be moved to reach a desired position. With respect to claim 47, it appears that the indicated direction that the tool

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must be moved is relative to a reference frame of the tool. Wilk et al disclose a surgical tool having a display on the tool. It would have been obvious to one skilled in the art to have modified Manwaring et al such that the display is mounted on the tool in order to provide a more compact system. With respect to claims 15, Manwaring discloses the use of a plurality of different displays.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Manwaring et al in view of Wilk et al (WO 93/15648) and Lundvall, I et al. Manwaring et al discloses an apparatus which includes a surgical tool and means for determining the actual position of the distal end of the tool relative to a desired position of the tool. Manwaring et al further provides a display for indicating such differences in position. Reference numeral 46 represents an indicator having electronic indicators which provide an indication to a human operator of a direction in which the tool should be moved to reach a desired position. Wilk et al disclose a surgical tool having a display on the tool. Lundvall, I et al disclose that it is known to indicate distance by varying a blink rate of a visible indicator to a user. It would have been obvious to one skilled in the art to have modified Manwaring et al such that the display is mounted on the tool in order to provide a more compact system. Furthermore, it would have been obvious to have indicated the distance that the tool needs to be moved by varying the blink rate of the visual indicator. Such a modification merely involves the substitution of one known type of distance indicator for another. With respect to claim 29, having the display means attached to the tool would result in determining the position of the display means when one determines the position of the tool.

#### ***Allowable Subject Matter***

Claims 1,7,9,11-13,42-43,49 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claims 22,26,31,44-45 are allowable over the prior art of record.

***Response to Arguments***

Applicant's arguments filed October 18, 2006 have been fully considered but they are not persuasive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth S. Smith whose telephone number is 571-272-4745. The examiner can normally be reached on M-F 7:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Ruth S. Smith', with a stylized, cursive script.

Ruth S. Smith  
Primary Examiner  
Art Unit 3737

RSS